

Application No.: 10/719,352
Paper Dated December 14, 2006
In Reply to Final Office Action of August 14, 2006
Attorney Docket No.: 3257-031853
Response Under 37 CFR § 1.116
Expedited Examining Procedure
Examining Group 3600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/719,352 Confirmation No. : 3304
Applicant : John R. Wall
Filed : November 21, 2003
Title : Connection System for Plastic Web Fencing
Art Unit : 3679
Examiner : Daniel J. Mills
Customer No. : 28289

MAIL STOP AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

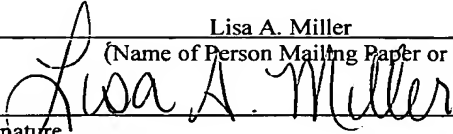
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

For the reasons set forth herein, Applicant respectfully submits that the Final Action is based upon improper rejections of the claims and does not establish the asserted *prima facie* case of obviousness based on the cited references.

I. Rejection of claim 1 under 35 U.S.C. §103(a) for obviousness over the Safe-Fence reference in view of U.S. Patent No. 5,661,878 to Johnson.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 14, 2006.

Lisa A. Miller
(Name of Person Mailing Paper or Fee)

Signature Date 12/14/2006

The Final Office Action dated August 14, 2006 fails to identify a motivation for making the combination of the teachings of the Safe-Fence reference with those of the Johnson patent to obtain the limitations of independent claim 1, resulting in a clear deficiency in establishing a *prima facie* case of obviousness in support of the rejection of claim 1. More specifically, the Examiner is wrong as a matter of law in his reliance on the Johnson patent to reject dependent claim 8.

As set forth on the bottom of page 5 of the Final Office Action, the Examiner asserts that although the Johnson patent may not be analogous art, it is nonetheless reasonably pertinent to the particular problem with which the inventor was concerned, and therefore it may still be relied upon as a basis for rejection (*In re Oetiker*, 997 F.2d 1443 (Fed. Cir. 1992)). The Examiner asserts that the teachings of the Johnson patent (i.e., constraining function) are pertinent to solving the problem of constraining the fence rail in the slotted connector. Therefore, the Examiner insists that the Johnson patent may still be relied upon in his rejection.

However, Applicant wishes to point out that the Examiner has not further inquired into the interpretation of the “reasonably pertinent” aspect of the test offered in *Oetiker*. According to the relevant case law, a “reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem” (*Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993)). The Johnson patent is clearly “in a different field from that of the inventor’s endeavor.” An inventor attempting to secure a fence rail would not have looked at the art of wrapping a box or other package via strapping, but rather to the field of fencing. As support for this assertion, for example, the Johnson buckle is a single buckle used to connect two opposite ends of a strap to opposing ends of the buckle to encircle the box. This is in contrast to how the current invention works – a slotted connector for securing a rail to a post. Another slotted connection is then required to connect the free end of the rail to another post. In view of the aforementioned case law and the application of law in those cases, Applicant believes that the Examiner is clearly wrong as a

matter of law in his reliance on the Johnson patent to reject the pending claims. The Examiner's reference to the Johnson patent appears to arise from impermissible hindsight.

The Johnson buckle is used to connect two opposing ends of a non-rigid strap *around* a package. Therefore, the Johnson patent deals with (a) wrapping packages (not fencing); and (b) a buckle for securing a non-rigid strap, as opposed to a rigid fence rail. Furthermore, the present invention does not require friction engaging roughened surfaces as in the Johnson invention. It has been held that absent a suggestion to combine the references, an Examiner can do no more than piece the invention together using the patented invention as a template – such hindsight reconstruction is impermissible (*Texas Instruments Inc. v. U.S. Intern. Trade Com'n.*, 988 F.2d 1165, 1178 (Fed. Cir. 1993)). It is Applicant's view that the Examiner is using improper hindsight to pick and choose a piece of the Johnson patent out of context from the other features that the Johnson patent discloses.

II. Rejection of claim 8 under 35 U.S.C. §103(a) for obviousness over the Safe-Fence reference in view of U.S. Patent No. 5,661,878 to Johnson.

The Final Office Action fails to show how the limitations of dependent claim 8 are met by either the Safe-Fence reference or Johnson patent. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Claim 8 requires that the rail be "rigid, yet manually deformable." As set forth on the bottom of page 4 of the Final Office Action, the Examiner has indicated that this limitation is met by Safe-Fence in the instance "when the rail is assembled with the connector and is pulled taut." However, the interwoven polymeric webbing polytape in Safe-Fence cannot in and of itself be construed as being rigid, let alone manually deformable. The Installation printout of Safe-Fence previously provided by the Examiner specifically states that one should be careful to "not over-stretch [the] polytape." This indicates that the tape is not a rigid material. Furthermore, one needs to "hand-tighten [the poly-tape] to eliminate sagging between fence posts." This indicates that the poly-tape cannot be manually deformed while still retaining its rigidity. The Examiner is construing the aforementioned limitation in

the context of an installed tape. The installed tape is simply not “rigid, yet manually deformable” given the plain meaning of such wording.

The Federal Circuit reviewed an application in which the claim related to an athletic shoe with cleats that “break away at a preselected level of force” and thus prevent injury to the wearer. The examiner rejected the claims over prior art teaching athletic shoes with cleats not intended to break off and rationalized that the cleats would break away given a high enough force. The court reversed the rejection stating that when interpreting a claim term which is ambiguous, such as “a preselected level of force”, we must look to the specification for the meaning ascribed to that term by the inventor. The specification had defined “preselected level of force” as that level of force at which the breaking away will prevent injury to the wearer during athletic exertion (*In re Weiss*, 989 F.2d 1202, 26 USPQ2d 1885 (Fed. Cir. 1993)).

For the same reasons as discussed in *Weiss*, one must look to the specification of the application in the instant case. Paragraph [0019] describes the rail as having a construction that is “conducive to manual deformation of the rail, yet retaining a high degree of stiffness in the rail. It is to be understood that any other type of rail fencing exhibiting stiffness and deformability qualities inherent in composite metal and plastic web fencing may also be utilized. For example, in the preferred embodiment, the rail is rigid enough that, when a section of it is placed on an edge of a tabletop, it is self-supporting.” The aforementioned description of the rail, whether in the preferred embodiment or otherwise, all refer to the rail itself being inherently rigid. Therefore, the “rigid, yet manually deformable” limitation cannot be equated to the Safe-Fence tape being in an assembled and pulled-taut state. Because the limitation of dependent claim 8 is not disclosed, suggested, or taught in the Safe-Fence reference or Johnson patent, a *prima facie* case of obviousness cannot be made.

III. Conclusion

Based upon the above specified clear errors, Applicant asserts that a *prima facie* rejection based on obviousness has not been established with respect to independent

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claim 1 and dependent claim 8. It is therefore respectfully requested that the final rejection be withdrawn and reversed.


Any questions regarding this submission should be directed to Applicant's undersigned representative, who can be reached by telephone at 412-471-8815.

The Commissioner for Patents is hereby authorized to charge any additional fees which may be required to Deposit Account No. 23-0650. Please refund any overpayment to Deposit Account No. 23-0650. One (1) original and two (2) copies of this Notice of Appeal are enclosed.

Respectfully submitted,

THE WEBB LAW FIRM

By



John W. McIlvaine
Registration No. 34,219
Attorney for Applicant
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com